

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

### Remarks

The Official Action rejected claims 1-5 and 8-21 under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-5 and 8-21 were rejected under 35 U.S.C. §102(b) based upon Goodwin, III et al. U.S. Patent No. 5,907,143 (Goodwin '143). Alternatively, claims 1-5 and 8-21 were rejected under 35 U.S.C. §103(a) based on Goodwin '143. These grounds of rejection are addressed below following a brief discussion of the present invention to provide context.

Claims 1, 3, 16, and 21 have been amended to be more clear and distinct. Claim 2 has been canceled without prejudice. Claims 6 and 7 have been previously canceled. Claims 1, 3-5, 8-21 are presently pending.

### The Present Invention

One aspect of the present invention relates to improvements in systems and methods which combine electronic price labels (EPLs) and electronic signs (ESs). As discussed in greater detail below, Goodwin '143 addresses an approach for an EPL system to also display promotional messages. In this approach, the promotional indicators are tied to an item record within a price lookup (PLU) file. As addressed at page 1, lines 16-21 of the present application, such an approach does not allow retailers to utilize an EPL which displays promotional information relating to groups of items or general sales events. With the prior art approach in which an EPL is assigned to a single item, a retailer cannot effectively advertise prices, such as bundled prices, that involve two or more different items. See also, page 2, lines 7-23.

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

As addressed in detail at page 6, line 1 – page 7, line 3, the present invention advantageously allows retailers to utilize an ES, such as ES 123 of Fig. 3, to display a promotion message without the ES being associated with an ITEM ID in a PLU file, such as PLU file 107. See, particularly, page 6, lines 17 and 18. To this end, ES 123 is associated with a promotional identification number in a EPL/ES data file, such as data file 109, and there is no associated promotional identification number in the PLU file. Thus, the PLU file may advantageously be modified and replaced without regard to promotional messages. Furthermore, ES may advantageously be located in a store away from the product or products it promotes. See present application, page 6, line 17 – page 7, line 3.

The claims as presently amended address a combined EPL and ES system or a method of operating such a system. Taking claim 1, by way of example, that claim requires an EPL/ES data file separate from the PLU file. The host computer reads this file to “determine whether an identification number” is a promotion identification number of an item identification number thereby allowing improved flexibility as discussed in greater detail in the present application. Claim 1 also now requires reading from a promotional data file to make clear that the PLU file is clear of any association with a promotional identification number.

#### Typographical Errors in the Specification

During the preparation of this response, a typographical error was noted and is now being corrected in the specification. The paragraph beginning at page 4, line 11 has been amended to remove the extraneous term “and.”

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

Section 112, Second Paragraph Rejection of Claims 1 and 16

Claim 1 has been amended to remove the objected to term “common” when referring to “host computer.”

The Official Action’s expresses concern that the phrase “and operating to send a message” is unclear because it precedes an “if” phrase. Although Applicants do not acquiesce to this objection, claim 1 has been amended to remove the “if” phrase following the activities of the host computer. To make more clear the host computer’s activities in response to the identification number, claim 1 has also been amended to remove the phrase “operating to send a message to the EPL if the identification number is associated with the EPL.” A limitation similar to this phrase has been added to claim 21.

With regard to claim 16, the Official Action suggests that it is unclear whether the term “an EPL” in line 3 is the same or different “EPL” of line 2. Line 2 of claim 16 as presently amended recites a “combined electronic price label (EPL) and electronic sign (ES) system,” whereas line 3 recites “reading a record associated with an EPL or an ES.” The first use of the acronym EPL is used in context of the name of the system being claimed. The second use of the acronym EPL is used to represent a specific electronic price label. Clearly a combined system is different than the electronic price label such that the term “an EPL” in line 3 is proper. It should be noted that although claim 16 has been amended to insert the term “label” after the term “electronic price”, this amendment was to correct the expansion of the acronym EPL.

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

### The Art Rejections

As addressed in greater detail below, Goodwin '143 does not support the Official Action's reading of it and the rejections based thereupon should be reconsidered and withdrawn. Further, the Applicants do not acquiesce in the analysis of Goodwin '143 made by the Official Action and respectfully traverse the Official Action's analysis underlying its rejections.

As an initial matter, the Applicants respectfully traverse the unnecessary and extensive legal discussion of the law governing the Applicants' right to be his own lexicographer while failing to specifically address how the Goodwin '143 applies to the limitations of the present claims. Much of the legal discussion is either incorrect, incomplete or inappropriate to the present context. Allocating a portion of the time spent on the unnecessary legal analysis to actual analysis of the claims and the references would have better served the prosecution process.

Also, the Applicants respectfully traverse the list of definitions of terms such as "relational model", "database", and the like which are not used in the present claims. Applicants maintain that the meaning of the terms utilized in the presently amended claims is clear. If there are specific ambiguities pointed out by the Examiner, the Applicant will address them accordingly. It should be noted that no objection to a specific claim term has been made other than one objection to the use of the word "common" which has been addressed by amendment.

Claims 1-5 and 8-21 were rejected under 35 U.S.C. §102(b) based upon Goodwin '143. Goodwin '143 advantageously addresses a method of displaying a promotional message by an electronic price label (EPL). Goodwin '143, col. 1, lines 18-20. To this end, Goodwin '143 utilizes a promotional data file along with a price lookup (PLU) file. The promotional data file

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

stores a promotional message and an associated promotional indicator. The PLU file stores an item's price and a promotional indicator associated with the item. (emphasis added) To display the promotional message, Goodwin '143's EPL computer reads the PLU file to obtain the promotional indicator for an item and retrieves the promotional message from the promotional data file. Goodwin '143, Fig. 4, steps 48 and 52. Goodwin '143's disclosure is silent with respect to displaying promotional messages independent of a particular item and each EPL in Goodwin '143 is associated with an item.

Unlike Goodwin '143, the present invention removes the dependency between a promotional message and an item. By removing such a relationship, the present invention advantageously provides support for electronic signs which are not associated with a particular item. Furthermore, a PLU file without a promotion identification number may be modified or replaced without regard to promotions being offered at a store. For example, a local store may offer promotions tailored to the inventory of the local store while receiving PLU files from a corporate office. In this example, the local store's system could download replacement PLU files and not be concerned with having to modify them to support the local store's promotions. To display a promotional message at an electronic sign, a host computer reads an EPL/ES data file which is separate from a PLU file. The host computer further reads the promotional message corresponding to the promotional identification number from a promotional data file. Since the dependency of a PLU file is removed, the PLU file may then be modified or replaced independently from offered promotions.

Claim 1, as presently amended, reads as follows:

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

1. (currently amended): A combined electronic price label (EPL) and electronic sign (ES) system comprising:  
an electronic sign (ES) for displaying a promotional message;  
a plurality of EPLs;  
a promotional data file;  
a price lookup (PLU) file; and  
a host computer reading an EPL/ES data file which is separate from the PLU file to determine whether an identification number stored in the EPL/ES data file is a promotion identification number associated with the ES or an item identification number associated with an EPL, said host computer reading the promotional message corresponding to the promotion identification number from the promotional data file and sending a message to the ES which includes a command for the ES to display the promotional message. (emphasis added)

Goodwin '143 does not disclose and does not make obvious "an EPL/ES data file which is separate from the PLU file," as presently claimed in claim 1. Goodwin '143 does not disclose and does not make obvious "reading the promotional message corresponding to the promotion identification number from the promotional data file," as presently claimed in claim 1. Goodwin '143 discloses reading a promotion identification number from a PLU file. See also claim 16.

Claims 1-5 and 8-21 were alternatively rejected under 35 U.S.C. §103(a) based upon Goodwin '143. As described above, Goodwin '143 does not make obvious the presently amended claims.

The Official Action also states that "if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Goodwin '143 to an additional EPL as an electronic sign." Applicants respectfully disagree. In one sense, the Examiner appears to be making an inherency argument. According to the MPEP Section 2112, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” The MPEP continues by further stating “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not met this burden here. As addressed above, Goodwin ‘143 is burdened by storing a promotion identification number in a PLU file and thus restricting promotions to be offered with respect to a particular item. See Figs. 2 and 3. In contrast to Goodwin ‘143, claim 1 of the present invention cites “, said host computer reading the promotional message corresponding to the promotion identification number from the promotional data file ....” Simply put, the presently claimed approach is not taught and is not rendered obvious by Goodwin ‘143.

In item 11, the Official Action suggests that conditional phrases are not necessarily limiting. Although the Applicants do not acquiesce to the suggestion that the conditional phrases used in previous claims are not limiting, claim 1 has been amended as described above.

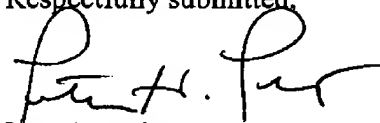
The claims of the present invention are not taught, are not inherent, and are not obvious in light of the art relied upon.

Appl. No. 09/847,795  
Amdt. dated January 19, 2005  
Reply to Office Action of November 4, 2004

Conclusion

All of the presently pending claims, as amended, appearing to define over the applied references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,



Peter H. Priest  
Reg. No. 30,210  
Priest & Goldstein, PLLC  
5015 Southpark Drive, Suite 230  
Durham, NC 27713-7736  
(919): 806-1600